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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/765,703	01/22/2001	Waifong Liew Anton	Rev 96-3B	2009
26807	7590	05/20/2004	EXAMINER	
JULIE BLACKBURN REVLON CONSUMER PRODUCTS CORPORATION 237 PARK AVENUE NEW YORK, NY 10017			WANG, SHENGJUN	
			ART UNIT	PAPER NUMBER
			1617	

DATE MAILED: 05/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/765,703	ANTON ET AL.	
	Examiner	Art Unit	
	Shengjun Wang	1617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 18 February 2004.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 40-63 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 40-63 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All
 - b) Some *
 - c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: _____.

DETAILED ACTION

Receipt of applicants' amendments and remarks submitted February 18, 2004 is acknowledged.

Claim Rejections 35 U.S.C. 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 41-63 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The claims, as amended, recite shine enhancing "film forming" homo or copolymer having index 1.5. The recitation lack support from the specification, or the claims, as originally filed with respect of "film forming." The application does not provide proper written description as to the shine enhancing polymers be film forming.

Claim Rejections 35 U.S.C. 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 41-63 are rejected under 35 U.S.C. 103(a) as being unpatentable over Castrogiovanni et al. (US 5,505,937, of record) in view of Mercado et al. (U.S. 4,996,044),

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Papantoniou et al. (3,911,105), Jacks et al. (U.S. 5,690,918), Mausner (US 5,352,441), and in further view of Kumar (US 5,468,477) with respect to claim 45, and Calello (US 6,143,283) to claim 57.

3. Castrogiovanni et al. et al. teaches a lipstick comprising a polymer, volatile oil, non-volatile oil, particulate pigment, wax employed herein and other ingredients well-known for lipstick, such as wax, isododecane, lanolin oil, dimethylsilicone, cyclomethicone, trioctyldodecyl citrate, etc. See the entire document, particularly, the examples, and the claims. Note the lipstick may also contain polymethacrylate or polyacrylate. See column 3, lines 25-26

4. The primary reference does not teach expressly the employment of the methacrylate polymers herein, or the vinylpyrrolidone copolymers, or fluorinated oil.

5. However, Papantoniou et al. teaches that poly methacrylate is known to be useful in lipstick composition for its film forming properties with other well-known ingredients such as silicone wax, lanolin oil etc. See, particularly, the abstract, column 1, lines 48 bridging to column 3, line 16; and example 18. The employment of such polymer renders the lipstick better quality than those without using polymer. See, column 1, lines 25-47. Mercado et al. teaches expressly the usefulness of polyacrylate polymer in lipstick formulation. See, particularly, column 3, lines 1-60, and example 18. Further, copolymers of vinylpyrrolidone are particularly known as film former in lipstick. See, particularly, the abstract, column 5, line 66 bridging column 6, line 10 in Jacks et al., the claims in Mausner.

6. Therefore, it would have been *prima facie* obvious to a person of ordinary skill in the art, at the time the claimed the invention was made, to modify the lipstick composition of

Castrogiovanni et al. by using the combination of acrylate polymer and vinylpyrrolidone copolymer.

A person of ordinary skill in the art would have been motivated to modify the lipstick composition of Castrogiovanni et al. using the combination of acrylate polymer and vinylpyrrolidone copolymer because methyl methacrylate polymer and vinylpyrrolidone copolymers are known to be useful in lipstick composition. Note it is *prima facie* obvious to combine two compositions each of which is taught in the prior art to be useful for same purpose in order to form third composition that is to be used for very the same purpose; idea of combining them flows logically from their having been individually taught in prior art; thus, the claimed invention which is a combination of two known film forming polymer known to be useful in lipstick sets forth *prima facie* obvious subject matter. See In re Kerkhoven, 205 USPQ 1069. The optimization of the percentage of each known ingredient in a cosmetic composition is considered within the skill of artisan, absent evidence to the contrary.

Claim 45 is rejected for reasons set forth above in further view of Kumar et al. Kumar et al. teach that isobornyl methacrylate is known to be similarly useful as methyl methacrylate as they polymerize to form polymers with similar glass transition temperature. See column 15, line 10 bridging column 16, line 11, particularly, column 16, lines 9-11. The employment of the particular polymethacrylate is seen to be a selection from amongst equally suitable material and as such obvious. Ex parte Winters 11 USPQ 2nd 1387 (at 1388).

Claim 57 is rejected for reasons set forth above in further view of Calello, Calello et al. teaches that fluorinated oil are known to be useful as non-volatile oil in lipstick composition.

See, particularly, col. 6, lines 36-49 and the claims. The employment of the particular nonvolatile oil is seen to be a selection from amongst equally suitable material and as such obvious. Ex parte Winters 11 USPQ 2nd 1387 (at 1388).

Response to the Arguments

Applicants' amendments, remarks, and the 132 declaration by Anjali Patil submitted February 18, 2004 have been fully considered, but are not persuasive for reasons discussed below.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Particularly, the 132 declaration by Patil argues the difference between a preferred example of Mercado and the methacrylate polymer herein employed. First, Mercado never limit the acrylate polymer to crosslinked polymer, see column 3 in Mercado. Question under 35 U.S.C. 103 is not merely what reference expressly teach, but what they would have suggested to one of ordinary skill in the art at the time the invention was made; all disclosures of prior art, including unpreferred embodiments, must be considered. In re Lamberti and Konort (CCPA), 192 USPQ 278. Further, Papantoniou et al. also do not limit the polymer to crosslinked polymer. In fact, Papantoniou et al teach soluble polymers, which is not crosslinked (see column 2, lines 37-48). Papantoniou et al. further disclose that the molecular weight of the molecules is in the range of 2000 to 500,000, and preferred 6,000 to 300,000. See column 3, lines 21-25. Mercado reference and Papantoniou et

al. reference shows that employment of acrylate polymers, including those claimed herein, in lipstick is old and well known.

In response to applicant's remarks that Jacks and Mausner references do not teach the polyvinylpyrrolidone herein, which require refractive index of 1.5 or greater, and which is a "film forming" polymer, as currently amended. The examiner disagrees. Applicants appears to suggest that the polyvinylpyrrolidone disclosed in the cited references has low molecular weight, and therefor is not qualified as film forming polymer. Particularly, applicants assert that Jacks teach the polyvinylpyrrolidone as an oil, not film forming polymer, and PVP may be different from each others with respect to the molecular weight, degree of polymerization (which is the same as molecular weight), crosslink. Applicants further assert that the PVP disclosed by cited reference does not have refractive index of 1.5 or greater, as herein recited. The examiner contend that Polyvinylpyrrolidone is polyvinylpyrrolidone, which is structurally clearly defined by its' name. The only possible difference of PVP is the molecular weight. Same polymers would have been reasonably expected to have the same physical properties, such as refractive index. Applicants erred in asserting that the PVP employed by Jacks is an oil. Note there is not limitation in the claims as to the molecular weight of polyvinylpyrrolidone. Any non-volatile compounds, including the PVP disclosed by the cited references are expected to function as film-forming ingredients. Further, the PVP employed by Jacks and Mausner consisting of the same monomer herein employed (pages 16-18). Since these polymers are essentially the same as those employed herein, they are deemed to have the physical properties herein claimed, such as refractive index. Applicants' attention is further directed to Mausner, where the PVP is not disclosed as oil.

As to the remarks about Kumar references, note, Kumar was cited to show that the particular methacrylate in the claims is known to be similarly useful as other methacrylate. Particularly, “Kumar et al. teach that isobornyl methacrylate is known to be similarly useful as methyl methacrylate as they polymerize to form polymers with similar glass transition temperature.” Again, question under 35 U.S.C. 103 is not merely what reference expressly teach, but what they would have suggested to one of ordinary skill in the art at the time the invention was made; all disclosures of prior art, including unpreferred embodiments, must be considered. *In re Lamberti and Konort (CCPA)*, 192 USPQ 278.

7. In response to applicant's argument that the examiner has combined an excessive number of references, reliance on a large number of references in a rejection does not, without more, weigh against the obviousness of the claimed invention. See *In re Gorman*, 933 F.2d 982, 18 USPQ2d 1885 (Fed. Cir. 1991).

8. In response to applicants' remarks of pick and choose, note the claims are directed to a cosmetic composition with the employment of two polymers well known in the cosmetic art. The claimed subject matters would have been obvious to one of ordinary skill in the art, as discussed above. No issue of pick and choose.

9. The declaration under 37 CFR 1.132 filed February 18, 2004 is insufficient to overcome the rejection of claims 41-60 based upon Castrogiovanni et al. (US 5,505,937, of record) in view of Mercado et al. (U.S. 4,996,044), Papantoniou et al. (3,911,105), Jacks et al. (U.S. 5,690,918), Mausner (US 5,352,441), and in further view of Kumar (US 5,468,477) with respect to claim 45, and Calello (US 6,143,283) as set forth in the last Office action because: as discussed above, the 132 declaration by Patil argues the difference between a preferred example of Mercado and

the methacrylate polymer herein employed, and the rejections are based on the combination of the cited references. Particularly, in view of the teaching of Mercado et al., and Papantoniou et al. the employment of acrylate polymers, including those herein employed, are well known in the cosmetic art.

10. In view of the foregoing, when all of the evidence is considered, the totality of the rebuttal evidence of nonobviousness fails to outweigh the evidence of obviousness.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shengjun Wang, Ph.D. whose telephone number is (571)272-0632. The examiner can normally be reached on Monday-Friday from 8:30 to 5:00.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan, can be reached on (571)272-0629. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9302.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-1600.

SHENGJUN WANG
PRIMARY EXAMINER



Shengjun Wang

May 11, 2004